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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,921	07/15/2005	Cetin Gurses	108396-00015	9013

4372 7590 03/11/2009

ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER	
SHOME, ARUNDIPTA	
ART UNIT	PAPER NUMBER
3771	

NOTIFICATION DATE	DELIVERY MODE
03/11/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

Office Action Summary	Application No.	Applicant(s)	
	10/500,921	GURSES, CETIN	
	Examiner	Art Unit	
	ARUNDIPTA SHOME	3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14 and 16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07-28-2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-14 and 16 are pending. This Action is in response to the amendment filed 11-14-2008.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 10, there is a lack of antecedent basis for "said generally spherical stimulator tip" on line 3.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-11, 13, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lavigne (US Patent 5,533,514) in view of Fenn (US Patent 5,279,284)

Regarding Claim 1, Lavigne discloses a device with maps for locating golgi tendons on muscles of the human body (col. 2, line 5). A tensiometric instrument 6 is shown, Fig. 1. This instrument measures and transmits pressure values (col. 4, lines 42-45). Means for displaying the values (computer 2, Fig. 1) are disclosed. A stimulator tip 18 is disclosed for applying local pressure to golgi tendon receptors.

An indication means (switch 7, Fig. 1) is shown for enabling the patient to inform the device of a pain pressure threshold upon feeling the pain.

Lavigne does not disclose a vibrator tip. Fenn discloses a vibrator tip 36 for massaging the skin, including means for actuating the vibrator tip for applying vibration (col. 3, lines 60-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the entire device as taught by Fenn to the device of Lavigne so that a soothing massage effect can reduce the pain imparted by the pain measurement device of Lavigne.

The modified Lavigne reference does not disclose that the vibrator tip is located within 25mm of the stimulator tip. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device to have the vibrator tip located within the claimed ranges since the only difference between the claimed invention and the prior art appears to be the dimensions recited in the claim -(See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.)

Regarding Claim 2, electronic input means (wire 10) are shown in Fig. 1 for indicating to the system the identification of GT points under exam.

Regarding Claim 3, Fig. 1 of Lavigne teaches a program memory (3), and means for compilation of the collected data and storing the data in the program memory. (column 5, line 57).

Regarding claim 4, Fig 1 of Lavigne teaches a computer system (2) for use with the algometer. A computer is capable of processing data and must contain a processor. The system from Lavigne is designed for identifying pain pressure points and pain thresholds. A display unit (13) is also disclosed in Lavigne to display results and information, and the computer can also print the results of the evaluation carried out.

Regarding Claim 5, Fig. 1 of Lavigne discloses an A/D converter (5) which converts the signal from the algometer to a digital form and transmits this to the computer (column 4, line 43).

Regarding Claim 6, the computer inherently has a hard drive on which the pain maps are stored (col. 3, lines 26-30).

Regarding Claim 7, the vibrator tip 36 of Fenn has a spherical tip (col. 1, line 46). The Fenn reference does not disclose that the spherical tip is 6-16mm in diameter. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tip to be in the claimed ranges because a device with the claimed dimensions would not perform differently than the prior art.

Regarding Claim 8, the Lavigne device is used for applying mechanical pressure to tendon receptors beneath the skin because it contacts the skin (col. 1, lines 45-55).

Regarding Claim 9, Lavigne discloses a method for locating golgi tendons in muscles with PSP continuous reflex cycles by using a stimulator tip 18. Also disclosed is measuring pain pressure thresholds on the receptors when the patient feels the pain associated with the applied pressure (col. 4, lines 42-45).

Lavigne also discloses applying a gradually increasing pressure to the skin until the pressure value reaches an inhibition threshold corresponding to the measured pain pressure threshold (col. 2, lines 25-30) since a gradually increasing pressure is applied to the skin until the patient presses the push button indicating that a threshold has been reached.

The modified Lavigne reference noted with respect to claim 1 includes a vibrator. The modified Lavigne reference does not disclose turning on the vibrator when the applied pressure exceeds the pain pressure threshold. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to turn on the vibrator when a pain threshold is reached so that a soothing massage effect can reduce the pain imparted by the pain measurement device of Lavigne.

The limitation of the spherical vibrator tip located within 25mm of the stimulator tip is noted with respect to claim 1.

Regarding Claim 10, Lavigne teaches an A/D converter 5 (Fig. 1) for converting stimulator tip readings into a digital format to a computer which contains a microprocessor. Lavigne also discloses a computer with a display system (13) for display of results such as pressure values.

Regarding Claim 11, Lavigne discloses identifying and recording pain points (col. 1, lines 53-57) and showing damaged areas on a map of the patient's body (Fig. 3).

Regarding Claim 13, Lavigne discloses processing the input data by the computer 2, and identification of pain pressure thresholds (col. 2, lines 25-30). Lavigne also discloses a display (13) to display results from the stimulator tip and the computer.

Regarding Claim 14, Lavigne does not explicitly disclose a method of calibrating the algometer instrument. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a calibration method for the instrument because all measuring instruments must be calibrated in some way to ensure accuracy of measurement. Lavigne also discloses a method of applying a range of pressure values- it is disclosed that "when the patient indicates that a threshold of pain has been reached by depressing a push-button connected to the algometer" (column 2, line 26). This implies that a range of increasing pressure values are applied to the patient's skin.

Regarding Claim 16, Lavigne discloses an electric switch 7 triggered by the patient upon feeling pain.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lavigne in view of Fenn as applied to claim 9 above, further in view of Platt (US PGPub 2001/0037222)

Regarding Claim 12, Lavigne teaches means for receiving and storing pain pressure points in a memory (3) recorded from the stimulator tip. Lavigne does not disclose predetermined pain pressure thresholds. Platt teaches predetermined pain pressure thresholds (para. 0025, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Lavigne to include predetermined pain pressure thresholds as taught by Platt so that a user can assess when a patient is undergoing an excess amount of pain.

Response to Arguments

6. Applicant's arguments filed 11-14-2008 have been fully considered but they are not persuasive.

Applicant has argued that the limitation of the vibrator tip located within 25mm of the stimulator tip is not taught by the prior art. However, if the difference between a claimed invention and the prior art is only a recitation of dimensions, the change in dimension is considered obvious usually considered obvious. It has been held that when a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. See In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984).

Applicant has also argued that Lavigne does not disclose applying a gradual increasing pressure to the golgi tendon points. However, Lavigne does appear to teach such a step on col. 2, lines 25-30 where it is stated that "the patient indicates that a threshold of pain has been reached by depressing a push-button connected to the algometer" (column 2, line 26). This implies that a range of increasing pressure values are applied to the patient's skin.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ARUNDIPTA SHOME whose telephone number is (571)270-5539. The examiner can normally be reached on Monday through Friday 9:00am to 6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S./
Examiner, Art Unit 3771

/Justine R Yu/
Supervisory Patent Examiner, Art Unit 3771